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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,445	11/28/2001	John Border	115426-1006	2403

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BELL, BOYD & LLOYD LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/996,445

Applicant(s)

BORDER ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8,10-12,15,17-19,22,24-26,29,31-36 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8,10-12,15,17-19,22,24-26,29,31-36 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/30/2006 have been fully considered but they are not persuasive.
2. With regard to claim 1, Applicant's arguments are moot in view of the new grounds of rejection, set forth below.
3. With regard to Applicant's assertion that Harrison teaches away from the claimed invention since Col 13, Lines 10-15 of Harrison "suggests that all HTML pages are cacheable" (Page 10 of Remarks), the Examiner respectfully disagrees. The cited portion of Harrison, as acknowledged by Applicant actually states "any number of other associated data object types, like HTML pages, may be classified as cacheable" (emphasis added). Clearly, this passage merely states that HTML pages may be classified as cacheable. No reasonable interpretation of the cited language would suggest that all HTML pages are cacheable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1,8,15,22,35 and their respective dependents are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. With regard to claim 1, the limitation “forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable” is not enabled by the specification. The specification states that objects that have a time to live are cacheable (¶41, Lines 9-10). Since a cacheable object would never be marked “uncacheable”, there is no way to forward an object based on this criteria, since no object would ever satisfy the criteria.

Based on ¶41 of the specification, it appears that these may be alternative criteria for forwarding, rather than complimentary criteria, but the current claim language does not capture such a relationship.

7. Claims 8,15,22 and 35 are rejected under the same rationale, since they contain a substantially identical limitation.

8. All claims not individually rejected are rejected by virtue of the dependency from the above claims.

Claim Rejections

9. Based on the Examiner's understanding of the present claim language (discussed in 35 U.S.C. 112 rejection, above), there is no known prior art which anticipates or makes obvious the current claim language, since it appears to contain an impossibility.

10. However, in the interest of expedited prosecution, the Examiner would like to note that when interpreting the limitation "forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable" as intending to refer to the criteria in the alternative, the rejection set forth in the Office action of 7/28/2006 would meet the limitation.

If Applicant intended to claim the forwarding criteria in the alternative, or if that is the intended interpretation of the present claim language, the rejections set forth in the Office action of 7/28/2006 should be considered maintained.

11. Since there is confusion regarding the language of the claims and the language of the specification, the Examiner recommends conducting an interview to discuss the forwarding criteria prior to filing a response in this case. The Examiner feels that prosecution could be expedited with an interview, and Applicant is encouraged to contact the Examiner to schedule one if he/she agrees.

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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS
2/9/07


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER